

REMARKS/ARGUMENTS

By this paper, Applicant responds to the Office Action of January 24, 2005 and respectfully requests reconsideration of the application. A Petition for Extension of Time extends time to respond through May 24, 2005.

Claims 1-30 are now pending, a total of 81 claims. Claims 1 and 19 are independent.

The amendments to the claims to recite "for storage in the memory of the computer" merely expressly recite a limitation that was previously inherent in the claims. These amendments neither alter the scope of the claims nor respond to any statutory patentability concern.

I. Double Patenting

The Office Action does not use any of the approved form paragraphs from Chapter 800 of the MPEP. It mixes reasoning and case citations that relate to statutory same-invention type double patenting and obviousness-type double patenting, without indicating which one is thought to apply. Because of the ambiguous statement of grounds, Applicant is unable to determine the appropriate responsive action. Without a clear statement of grounds, no rejection exists.

Second, double patenting is an analysis that must be conducted on a claim-by-claim basis. The double-patenting form paragraphs and each subsection of MPEP § 804 require the identification of particular pairs of claims, and a showing that one particular claim in the pending application is element-for-element identical to, or an obvious variant of, one particular claim of the other. For example, MPEP § 804(B)(1) instructs that when making an obvious-type double patenting analysis, the following factual inquiries must be set forth:

- (A) Determine the scope and content of a patent claim [singular] and the prior art relative to a claim [singular] in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim [singular] and the prior art as determined in (A) and the claim [singular] in the application at issue;

The case law is even clearer, *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970), emphasis added:

Application Serial No. 09/425,401
Attorney Docket No. 114596-09-4016

Amendment Dated May 23, 2005 – Response to Office Action of January 24, 2005

A good test, and probably the only objective test, for "same invention," is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.

Because the Office Action never makes an element-by-element comparison of one particular claim of this application to one particular claim of the '852 application, no double patenting rejection exists.

Third, the Office Action makes no attempt to show that the limitations of the independent claims of application serial no. 09/330,852 have any analogy whatsoever in the claims of this application, let alone an "identical" limitation that would support same-invention double patenting:

- recording profile information concerning the execution of the program, the profile information recording of the address of the last byte of at least one instruction (claims 1, 2 and 24 of the '852 application)
- ... the program being coded in an instruction set in which an interpretation of an instruction depends on a processor mode not expressed in the binary representation of the instruction; [and] recording profile information ... efficiently tailored to annotate the profiled binary code with sufficient processor mode information to resolve mode-dependency in the binary coding. (claims 1, 34 and 46 of the '852 application).

In contrast, none of the independent claims of this application recite either of these limitations.

No double patenting rejection could be raised.

No rejection exists. Applicant cannot respond until a clear statement of grounds is set forth in the manner required by the MPEP.

II. Claims 1 and 19

Claim 1 recites as follows:

1. A method, comprising:

during a profiled interval of an execution of a program on a computer, recording profile information describing the execution, without the program having been compiled for profiled execution, the program being coded in an instruction set in which an interpretation of an instruction depends on a processor mode not expressed in the binary representation of the instruction, the recorded profile information describing at least all events occurring during the profiled execution interval of the two classes:

a divergence of execution from sequential execution;

a processor mode change that is not inferable from the opcode of the instruction that induces the processor mode change taken together with a processor mode before the mode change instruction;

the profile information further identifying each distinct physical page of instruction text executed during the execution interval.

As noted in Applicant's paper of August 2004, the Office Action fails to show that the "profile information [identifies] each distinct physical page." The Office Action merely indicates that Heisch '033 teaches that a program executes, and that execution is profiled. The Office Action makes no attempt to show that any "physical" address or page is identifiable in the profile information. The Office Action raises no rejection.

Profiling typically proceeds by recording virtual addresses, not physical addresses. The indicated portions of Heisch '033 contain no suggestion of a departure from this typical practice.

The "Response to Arguments" in the Office Action of January 2005 has nothing to do with the arguments that were made in Applicant's paper of August 2004. The Office Action makes no response whatsoever to the "physical page" ground of traverse that was discussed in August 2004. Instead, inexpicably, the January 2005 Office Action discusses "recording the address of the last byte of at least one instruction." This claim language appears in no claim of this application. This fact was expressly pointed out in Applicant's paper of August 2004.

No rejection exists, and the Office Action of January 2005 fails to "Answer All Material Traversed."

III. Conclusion

This application has been pending for over five years, and has not yet been examined. Applicant respectfully requests a *bona fide* examination.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. An Petition for Extension of Time extends time for one month. In the event that further extension of time is required, Applicant petitions

FROM WILLKIE FARR 37FAX DEPT

Application Serial No. 09/425,401

Attorney Docket No. 114596-09-4016

Amendment Dated May 23, 2005 - Response to Office Action of January 24, 2005

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for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-09-4016.

Respectfully submitted,

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Dated: May 23, 2005

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